

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Benoist SEBIRE et al.
Serial No. : 09/937,949
Filed : August 5, 2002
Examiner : Salman Ahmed
Group Art Unit : 2616
Title : COMMUNICATIONS SYSTEM

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

February 7, 2007

**RESPONSE TO OFFICE ACTION AND REQUEST FOR WITHDRAWAL OF FINALITY
OF OFFICE ACTION DUE TO NEW GROUNDS OF REJECTION**

Sir:

Applicants acknowledge the Office Action dated November 7, 2006. The Office Action repeats the grounds of rejection that the claims are obvious over the Dent patent (U.S. Patent No. 6,084,865) in view of the Tran patent (U.S. Patent No. 5,517,504). The Office Action also contains a "Response to Arguments" section on pages 15-19 that purportedly responds to applicants' arguments filed on October 18, 2006 that the Tran patent would not motivate one of ordinary skill in the art to modify the Dent patent so as to arrive at the claimed invention. However, the Response to Arguments section does not merely respond to applicants' arguments. It twice attempts to introduce a new grounds of rejection that: 1) is irrelevant to the issue of whether the Tran patent would have motivated one of ordinary skill in the art to modify the Dent patent; 2) is not an appropriate rejection of the claims; or 3) can not properly be made final.

1) Applicants' arguments of October 18, 2006 necessarily only addressed the rejection that was made in the previous Office Action (that one of ordinary skill in the art would have been motivated by the Tran patent to modify the Dent patent such that the resulting combination would read on the claimed invention). Thus, a true response to applicants' arguments would likewise only address applicants' traversal of the assertion of motivation in the rejection. However, the "response to Arguments" section twice makes the following superfluous statement:

"Rigid prophylactic test is not needed to implement section 103(a)'s nonobviousness requirement. Teaching-Suggestion-Motivation Test Should Not be The Exclusive Means of Establishing Obviousness. There may be differences between respondent's invention and the state of the prior art. The gap between the prior art and respondent's system is simply not so great as to render the system non-obvious to one reasonably skilled in the art. Id. At 230. (No. 04-1350 In the Supreme Court of the United States KSR INTERNATIONAL CO., PETITIONER v. TELEFLEX INC., ET AL.)"

This statement is clearly **irrelevant** to applicant's arguments directed to the combination of Dent in view of Tran based on the alleged motivation in the Tran patent. Indeed, the statement itself indicates that it is **an alternative to** the grounds of rejection based on alleged motivation in the Tran patent. While the Patent Office may introduce a new grounds of rejection at its discretion, it should do so plainly in the Office Action and in a manner by which applicants are enabled to traverse the new grounds. It is blatantly unfair and a violation of applicants' procedural due process rights to include such an alternative grounds in a purported response to different arguments.

2) The KSR International case is presently pending. The Supreme Court of the United States has not yet rendered its decision. Thus, any of the statements made in the case may not be cited as applicable legal precedent unless and until the Supreme Court renders such a decision.

3) Finally, while the Patent Office may introduce a new grounds of rejection at its discretion, it is a violation of the Patent Rules for the new grounds of rejection to be made final. Applicants have been afforded no opportunity to file a complete response to this new grounds of rejection, including any amendments that it may see as appropriate.

Respectfully Submitted,



Date: February 7, 2007

Robert Bauer, Reg. No. 34,487
LACKENBACH SIEGEL LLP
One Chase Road
Scarsdale, NY 10583